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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 09/407,839  | 09/29/1999  | Erkki Yli-juuti      | 017.37357X00        | 3287             |
| 20457   | 7590        | 01/05/2004           | EXAMINER            |                  |
| ANTONELLI, TERRY, STOUT & KRAUS, LLP<br>1300 NORTH SEVENTEENTH STREET<br>SUITE 1800<br>ARLINGTON, VA 22209-9889 |             |                      | GANTT, ALAN T       |                  |
|   |             | ART UNIT             |                     | PAPER NUMBER     |
|   |             | 2684                 |                     | 7                |
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Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                        |                     |  |
|------------------------------|------------------------|---------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b> | <b>Applicant(s)</b> |  |
|                              | 09/407,839             | YLI-JUUTI ET AL.    |  |
| <b>Examiner</b>              | <b>Art Unit</b>        |                     |  |
| Alan T. Gantt                | 2684                   |                     |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 29 September 1999.

2a) This action is FINAL.                  2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-59 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1-59 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. §§ 119 and 120

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some \* c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a)  The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

#### Attachment(s)

|  |  |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                  | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ . |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>5</u> . | 6) <input type="checkbox"/> Other: _____ .                                   |

## **DETAILED ACTION**

### ***Claim Objections***

Claims 37 and 38 are objected to because of the following informalities: Claim 37 states that first message transmitting means comprises a cellular telephone. Claim 38 states “wherein said telephone comprises a cellular telephone”. The examiner believes that since claim 37 is depending from claim 21 and claim 22 states that the first transmitting means comprises a telephone, claim 38 should be canceled as logically claim 38 would depend from claim 22. In either case there would be duplicate claims. The examination was performed assuming that claims 37 and 38 are duplicates. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-27, 32-46, and 48-53 are rejected under 35 U.S.C. 102(e) as being anticipated by Chen.

Regarding claim 1, Chen discloses an automated consumer response system to publicly broadcast information and consequently provides a method of providing an identification of a broadcast piece of information to a person receiving the broadcast (Col. 1, lines 4-11), said method comprising, the steps of:

(a) on a first receiver, receiving the broadcast; (col. 1, lines 45-64)

- (b) sending a first message describing the piece of information to a centralized information identification location having a data base storing data for identifying pieces of information; (col. 3, lines 21-43 and col. 4, lines 41-60)
- (c) at the centralized information identification location, comparing the first message with pieces of information stored in the data base; (col. 4, lines 41-60) and
- (d) identifying the piece of information on the basis of the comparison. (col. 4, lines 50-60)

Regarding claims 2, and 22, Chen discloses activating a telephone to send the first message (col. 3, lines 21-43).

Regarding claims 3 and 23 Chen discloses sending an electronic mail message (col. 3, lines 21-43).

Regarding claims 4, 24, Chen discloses (e) sending to an identified receiving location a second message including the identification of the musical piece (col. 4, lines 61 to col. 5, line 22).

Regarding claims 5, 25, Chen discloses activating a telephone to send the second message (col. 3, line 50-64 and col. 4, lines 61 to col. 5, line 22).

Regarding claims 6 and 26, Chen allows for the second message to involve sending an electronic mail message (col. 4, lines 61 to col. 5, line 22).

Regarding claims 7, Chen allows for the second message to involve providing additional information about the piece of information piece (col. 5, line 35 to col. 6, line 6).

Regarding claim 8, Chen discloses a method that includes making a recording of

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at least a portion of the piece of information, activating a telephone to place a call to the centralized information identification location, and playing the recording so as to send the portion of the piece of information to the centralized information identification location (col. 1 line 65 to col. 2, line 15 and col. 4, lines 41-60).

Regarding claim 9, Chen meets the limitation, “a method as claimed in claim 8, wherein step (c) comprises comparing the piece of information with pieces of information stored in the database” (col. 5, lines 50-60).

Regarding claim 10, Chen meets the limitation, “method as claimed in claim 1, wherein step (b) comprises activating a telephone to place a call to the centralized information identification location while the broadcast station is broadcasting the piece of information so as to send at least a portion of the piece of information to the centralized information identification location (col. 1 line 65 to col. 2, line 15 and col. 4, lines 41-60).

Regarding claim 11, Chen meets the limitation, “A method as claimed in claim 10, wherein step (c) comprises comparing the piece of information with pieces of information stored in the database” (col. 4, lines 41-60).

Regarding claim 12, Chen meets the limitation, “A method as claimed in claim 1, wherein step (b) comprises activating a telephone to place a call to the centralized information identification location, and identifying a broadcasting station that is broadcasting the piece of information and the time that the broadcast station broadcast the piece of information” (col. 5, line 23 to col. 6, line 6).

Regarding claim 13, Chen meets the limitation, “A method as claimed in claim 12, wherein step (c) comprises interrogating a play list stored in the database for the identified broadcasting station (col. 3, lines 47-64).

Regarding claim 14, Chen meets the limitation, “A method as claimed in claim 1, wherein step (b) comprises activating a telephone to place a call to the centralized information identification location while a broadcasting station is broadcasting the piece of information, and identifying the broadcasting station; and step (c) comprises tuning a second radio receiver to the identified broadcasting station, receiving the broadcast, and comparing the piece of information with pieces of information stored in the database” (col. 1, line 65 to col. 2, line 15 and col. 4, lines 41-60).

Regarding claim 15, Chen meets the limitation, “A method as claimed in claim 1, wherein step (b) comprises sending a message describing the piece of information and ordering a copy of the piece of information; and wherein said method further comprises the step of:

(e) sending an order for the piece of information to an order shipping center” (col. 5, lines 7-22).

Regarding claim 16, Chen meets the limitation, “A method as claimed in claim 1, wherein the piece of information is a video piece” (col. 3, line 47-64).

Regarding claim 17, Chen meets the limitation, “A method as claimed in claim 1, wherein the piece of information is a audio piece (col. 3, line 47-64).

Regarding claim 18, Chen meets the limitation, “A method as claimed in claim 17, wherein the piece of information is a musical piece (col. 3, lines 21-43).

Regarding claim 19, Chen meets the limitation, "a method as claimed in claim 18, wherein step (e) includes providing additional information about the musical piece (col. 3, lines 21-43 and col. 5, line 42 to col. 6, line 6).

Regarding claim 20, Chen meets the limitation, "A method as claimed in claim 19, wherein the additional information includes the composer of the musical piece (col. 5, line 35 to col. 6, line 6).

Regarding claim 21, Chen discloses an automated consumer response system to publicly broadcast information and, consequently, provides a system for providing an identification of a broadcast piece of information to a person receiving the broadcast, said system comprising:

a receiver for receiving the broadcast and providing a signal reproducing the piece of information; (col. 1, lines 45-64, col. 4, lines 18-37)

first message transmitting means for transmitting a first message describing the piece of information; (col. 3, lines 21-43) and

a centralized information identification location, including:

means for receiving the first message (col. 3, lines 47-64);

a data base storing data for identifying pieces of information broadcast by a plurality of broadcasting stations; (col. 1, lines 41-60) and

an information identification unit responsive to the description of the piece of information in the received first message for locating data in said data base identifying the piece of information. (col. 1, lines 41-60)

Regarding claim 27, Chen meets the limitation, "A system as claimed in claim 21, wherein said first message transmitting means is electrically coupled to said receiver to transmit the piece of information as it is received by said receiver (col. 5, line 42 to col. 6, lines 8).

Regarding claim 32, Chen meets the limitation, "A system as claimed in claim 21, wherein said first transmitting means transmits at least a portion of the piece of information (col. 3, lines 21-43).

Regarding claim 33, Chen meets the limitation, "A system as claimed in claim 32, wherein said information identification unit compares the portion of the piece of information with data stored in said data base (col. 4, lines 41-60).

Regarding claim 34, Chen meets the limitation, "A system as claimed in claim 21, wherein said first transmitting means transmits an identification of the broadcasting station and the time the broadcasting station broadcast the piece of information (col. 5, lines 42-56).

Regarding claim 35, Chen meets the limitation, "A system as claimed in claim 34, wherein said information identification unit compares the time the identified broadcasting station played the piece of information with a play list for the identified broadcasting station to identify the piece of information (col. 5, lines 42-56 and col. 4, lines 41-60).

Regarding claim 36, Chen meets the limitation, "A system as claimed in claim 21, wherein said music identification unit responds to identification of a broadcasting station then playing the piece of information by tuning a second receiver to the identified broadcasting station

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to receive at least a portion of the piece of information, and comparing the received portion with data stored in the data base (col. 4, lines 41-60).

Regarding claim 37, Chen meets the limitation, "A system as claimed in claim 21, wherein said first message transmitting means comprises a cellular telephone (col. 3, lines 21-43).

Regarding claim 38, Chen meets the limitation, "A system as claimed in claim 37, wherein said telephone comprises a cellular telephone (col. 3, lines 21-43).

Regarding claim 39, Chen meets the limitation, "A system as claimed in claim 21, wherein said first message transmitting means comprises an electronic mail terminal (col. 3, lines 21-43).

Regarding claim 40, Chen meets the limitation, "A system as claimed in claim 21, wherein said second message transmitting means comprises a telephone" (col. 3, lines 47-64).

Regarding claim 41, Chen meets the limitation, "A system as claimed in claim 21, wherein said second message transmitting means comprises an electronic mail terminal (col. 4, lines 61 to col. 5, line 22).

Regarding claim 42, Chen meets the limitation, "A system as claimed in claim 21, further comprising means for sending an order for a copy of the piece of information to an order shipping center (col. 5, lines 7-22).

Regarding claim 43, Chen meets the limitation, "A system as claimed in claim 21, wherein said receiver comprises a radio receiver (col. 5, lines 23-41).

Regarding claim 44, Chen meets the limitation, "A system as claimed in claim 21, wherein said receiver comprises a television receiver (col. 5, lines 23-41).

Regarding claim 45, Chen discloses an automated consumer response system to publicly broadcast information and, consequently, provides a method of providing an identification of a musical piece to a person listening to a radio station which is playing the musical piece, said method comprising the steps of:

- (a) providing a data base storing data for identifying the musical pieces (col. 4, lines 18-60),
- (b) receiving a telephone message describing the musical piece and identifying a receiving location to which identification of the musical piece is to be sent, (col. 3, lines 47-64 and col. 4, lines 18-37)
- (c) interrogating the data base to identify the musical piece, (col. 4, lines 41-60) and
- (d) sending to the identified a receiving location a message including the identification of the musical piece. (col. 4, lines 18-37)

Regarding claim 46, Chen meets the limitation, "A method as claimed in claim 45, wherein step (c) comprises comparing the musical piece with musical pieces stored in the data base (col. 4, lines 41-60).

Regarding claim 48, Chen meets the limitation, "A method as claimed in claim 45, wherein step (b) comprises receiving a telephone message identifying the radio station and the time that the radio station played the musical piece; (col. 5, lines 42-56)

and step (c) comprises interrogating a play list stored in the data base for the identified radio station (col. 4, lines 41-60).

Regarding claim 49, Chen meets the limitation, "A method as claimed in claim 45, wherein step (b) comprises receiving a telephone message identifying the radio station while the radio station is playing the musical piece; and step (c) comprises tuning a radio receiver to the identified radio station, receiving the radio broadcast, and comparing the musical piece with musical pieces stored in the data base (col. 5, lines 42-56 and col. 4, lines 41-60).

Regarding claim 50, Chen meets the limitation, "A method as claimed in claim 45, wherein step (d) comprises sending the message to an identified telephone (col. 3, lines 47-64).

Regarding claim 51, Chen meets the limitation, "A method as claimed in, claim 45, wherein step (d) comprises sending the message to an identified electronic mail address (col. 4, line 61 to col. 5, line 16).

Regarding claim 52, Chen meets the limitation, "A method as claimed in claim 45, wherein step (b) includes receiving a telephone message ordering a copy of the musical piece; and said method further comprises the step of (e) sending an order for the musical piece to an order shipping center (col. 5, lines 8-22).

Regarding claim 53, Chen discloses an automated consumer response system to publicly broadcast information which includes a system for providing an identification of a musical piece to a person listening to a radio station which is playing the musical piece in a radio broadcast (col. 3, lines 47-64), said system comprising:

a first telephone for receiving a message describing a musical piece that has been

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played in a radio broadcast on a radio station, and identifying a receiving location to which identification of the musical piece is to be sent; (col. 4, lines 18-37)

a database storing data for identifying musical pieces played by a plurality of radio stations; (col. 4, lines 41-60)

a music identification unit responsive to the description of the musical piece in the telephone message for locating data in said data base identifying the musical piece; (col. 4, lines 41-60) and

means for transmitting to the identified receiving location a message identifying the musical piece. (col. 4, lines 18-37; col. 5, lines 17-22)

Regarding claim 54, Chen meets the limitation, "A system as claimed in claim 53, wherein, said music identification unit compares the musical piece with data stored in said data base (col. 4, lines 41-60).

Regarding claim 55, Chen meets the limitation, "A system as claimed in claim 53, wherein said music identification unit compares the time an identified radio station played the musical piece with a play list for the identified radio station to identify the musical piece (col. 4, lines 41-60 and col. 5, lines 42-56).

Regarding claim 56, Chen meets the limitation, "A system as claimed in claim 53, wherein said music identification unit is responsive to identification of a radio station then playing the musical piece for tuning a radio receiver to the identified radio station to receive at least a portion of the musical piece and comparing the received portion with musical pieces stored in the data base (col. 4, lines 41-60).

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Regarding claim 57, Chen meets the limitation, "A system as claimed in claim 53, wherein said transmitting means comprises a second telephone (col. 3, lines 47-64).

Regarding claim 58, Chen meets the limitation, "A system as claimed in claim 53, wherein said transmitting means comprises means for transmitting the message by electronic mail (col. 4, line 61 to col. 5, line 16).

Regarding claim 59, Chen meets the limitation, "A system as claimed in claim 53, further comprising means for sending an order for a copy of the musical piece to an order shipping center (col. 5, lines 8-22).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 28-31 and 47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chen, in view of Lee et al.

Regarding claim 29, Chen discloses an automated consumer response system to publicly broadcast information and, consequently, provides a system for providing an identification of a broadcast piece of information to a person receiving the broadcast as stated

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above for claim 21. However, Chen is silent regarding utilizing a recorder coupled to the receiver for recording the piece of information.

Lee discloses a combination cellular telephone radio receiver and recorder mechanism for vehicles. The tape recorder is used to record telephone messages being received and sent by the cellular telephone. As the recorder is able to record the user's voice, it can also record music acoustically received from the radio receiver, which can be used to transmit the musical piece to the musical identification unit by way of the telephone (Abstract and col. 2, lines 23-40). Typically, there will be facilities for taping for the auxiliary sources, thus, allowing for an electrical coupling between the first transmitting means, which is the telephone, and the recorder (Figures 1 and 2). Thus, Lee meets the limitation, "A system as claimed in claim 21, further comprising a recorder electrically coupled said receiver for recording the piece of information" (Figures 1 and 2).

Chen and Lee are combinable because they share a common endeavor, namely utilizing broadcast receiver means and telephone transmitting means. At the time of the applicant's invention it would have been obvious to modify Chen to include a recording means as done by Lee to enable recording of sources to be transmitted by the telephone.

Regarding claim 28, Chen meets the limitation, "A system as claimed in claim 21, wherein said first message transmitting means is acoustically coupled to said receiver to transmit the piece of information as it is received by said receiver (col. 4, line 9-17).

Regarding claim 30, Lee meets the limitation, "A system as claimed in claim 29, wherein said first message transmitting means is electrically coupled to said recorder to transmit the piece

of information as the piece of information is played back by the recorder" (Abstract and col. 2, lines 23-40).

Regarding claim 31, Lee meets the limitation, "A system as claimed in claim 29, wherein said first transmitting means is acoustically coupled to said recorder to transmit the piece of information as the piece of information is played back by the recorder (Abstract and col. 2, lines 23-40 [the fact that the receiver is on while the telephone call {consumer transmitter} is made to the processing center allows for the piece of information to be transmitted]).

Regarding claim 47, Lee meets the limitation, "A method as claimed in claim 45, wherein step (b) comprises receiving a telephone message including at least a portion of the musical piece; and step (c) comprises comparing the musical piece with musical pieces stored in the data base (Abstract and col. 2, lines 23-40 [the fact that the receiver is on while the telephone call {consumer transmitter} is made to the processing center allows for the piece of information to be transmitted]).

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Larson, Jr. discloses a radio station program identifier and distribution system for creating custom recordings.

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Pocock discloses a system for on demand remote access to a self generating audio recording, storage, indexing and transaction system.

Mankovitz discloses a method and apparatus for providing information in response to telephone requests.

Goldman discloses a digital radio broadcast station that includes selection and retrieval of music from a digital database.

Deguchi discloses a system for searching a database for information associated with broadcast segments based upon broadcast time.

Any inquiry concerning this communication from the examiner should be addressed to Alan Gantt at telephone number (703) 305-0077. The examiner can normally be reached between 9:30 AM and 6 PM within the Eastern Time Zone. The group FAX number is (703) 872-9306.

Any inquiry of a general nature or relating to this application should be directed to the group receptionist at telephone number (703) 305-4700.

*Alan T. Gantt* *McCloskey*  
Alan T. Gantt

December 23, 2003